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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/049,315

02/08/2002

Yuji Sawada

56924 (70551)

3720

21874 7590 10/15/2009
EDWARDS ANGELL PALMER & DODGE LLP
P.O. BOX 55874
BOSTON, MA 02205

EXAMINER

STORK, KYLE R

ART UNIT

PAPER NUMBER

2178

MAIL DATE

DELIVERY MODE

10/15/2009

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YUJI SAWADA

Appeal 2009-002970
Application 10/049,315¹
Technology Center 2100

Decided: October 15, 2009

Before LANCE LEONARD BARRY, JAY P. LUCAS, and DEBRA K.
STEPHENS, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application filed February 8, 2002. Appellant claims the benefit under Japan application 11-226607, filed August 2, 2000. The real party in interest is Sharp Kabushiki Kaisha.

STATEMENT OF THE CASE

Appellant appeals from a final rejection of claims 1-22 under authority of 35 U.S.C. § 134(a) (App. Br. 1, middle). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

Appellant's invention relates to an organization of the contents of electronic books to facilitate the inclusion of images, text, and sound objects. In the words of Appellant:

In order to replace the image data "Fig.jpg" with another image data, for example, "Fig2.jpg", at two locations must be retrieved and corrected. In particular, when the body is longer and accordingly the same images are used at an increased number of locations, a problem arises that replacement of the images becomes more difficult.

....

Electronic book contents recited in claim 1 include a body data unit and a part data unit. The body data unit includes event data including a description for designating a display region and a first identifier for designating contents displayed on the display region. The part data unit includes display data divided into a plurality of regions with the first identifier added thereto.

As the event data includes the description for designating the display region and the first identifier for designating the contents displayed on the display region, the display data can be acquired and then displayed on the display region by referring to the first identifier added to the display data.

(Spec. 4, bottom; 5, middle).

Claims 1, 8, and 18 are exemplary:

Claim 1: Electronic book contents comprising a body data unit and a part data unit,

said body data unit including event data including a description for designating a display method and a first identifier for designating contents displayed on a display region, and

said part data unit including a file name of display data divided into a plurality of regions with said first identifier added thereto,

wherein the display data in said part data unit is entered as an object separately from said body data unit, and

said body data unit includes no data to be actually displayed on the display region.

Claim 8: A computer-readable recording medium having electronic book contents recorded thereon, said electronic book contents including a body data unit and a part data unit,

said body data unit including event data including a description for designating a display method and a first identifier for designating contents displayed on a display region, and

said part data unit including a file name of display data divided into a plurality of regions with said first identifier added thereto,

wherein the display data in said part data unit is entered as an object separately from said body data unit, and

said body data unit includes no data to be actually displayed on the display region.

Claim 18: A computer data signal generated by encoding electronic book contents processed by a computer to be displayed on a display screen, said data signal being a carrier transmitted via a network,

said electronic book contents including a body data unit and a part data unit,

said body data unit including event data including a description for designating a display method and a first identifier for designating contents displayed on a display region, and

said part data unit including a file name of display data divided into a plurality of regions with said first identifier added thereto,

wherein the display data in said part data unit is entered as an object separately from said body data unit, and

said body data unit includes no data to be actually displayed on the display region.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Shwartz	US 5,524,201	Jun. 04, 1996
Form	US 6,281,986	Aug. 28, 2001
Tonomura	US 6,571,054 B1	May 27, 2003

Source code from *The Declaration of Independence: A History*, June 6, 1997,
<http://web.archive.org/web/19970606080409/http://www.nara.gov/exhall/characters/declaration/dechist.html> (hereinafter “History”).

Cascading Style Sheets, level 1, January 11, 1999,
<http://www.w3c.org/TR/CSS1> (hereinafter “Style”).

REJECTIONS

The Examiner rejects the claims as follows:

R1: Claims 1, 2, 8, 9 and 18 stand rejected under 35 U.S.C. § 103(a) for being obvious over History in view of Style.

R2: Claims 3, 10, 19 and 21 stand rejected under 35 U.S.C. § 103(a) for being obvious over History in view of Style and further in view of Tonomura.

R3: Claims 4 and 11 stand rejected under 35 U.S.C. § 103(a) for being obvious over History in view of Style and further in view of Tonomura and Shwarts.

R4: Claims 5, 7, 12, 14, 20 and 22 stand rejected under 35 U.S.C. § 103(a) for being obvious over History in view of Style and further in view of Form.

R5: Claims 6, 13, 15 and 17 stand rejected under 35 U.S.C. § 103(a) for being obvious over History in view of Style and further in view of Kikinis.

Appellant has chosen to argue only the rejections [R1] and [R5], encompassing the independent claims 1, 8, 15, 17 and 18. (App. Br. 7, middle). Thus the dependent claims of rejections [R2] to [R4] will stand or fall with their respective independent claims.

Claim 1 and those claims dependent thereon are subject to a Board imposed rejection under 35 U.S.C. § 101 for being non-statutory for failing to encompass patentable subject matter, as will be described below.

Claim 18 is also subject to a Board imposed rejection under 35 U.S.C. § 101 for being non-statutory, being addressed to an electronic signal. This will also be described below.

Therefore there remains only the adjudication of the Examiner's rejections [R1] with respect to claims 8 and 9 and [R5] with respect to claims 13, 15 and 17.

Appellant contends that the claimed subject matter is not rendered obvious by History in view of Style and, with respect to rejection [R5], Kikinis, for failure of the references to teach the claimed subject matter. The Examiner contends that each of the claims is properly rejected.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellant have been considered in this opinion. Arguments that Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived.

We affirm the Examiner's rejections [R1] and [R5].

ISSUES

The first issue is whether Appellant has shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue turns on whether the references teach the body data unit and part data unit where the body data unit includes no data to be actually displayed on the display screen. A second issue is raised by this tribunal concerning whether the claims meet the requirements for statutory subject matter under the law.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellant has invented an organization of the content of electronic books that facilitates the placement of images, special text, and even sound into the body of electronic books (Spec. 4, bottom). The book is divided into a body data section, which contains the structure of the document, and a part data section, which contains the images, text, or sound objects (Spec. 5, middle). Identifiers placed into the body data section locate the place in the structure that the image, text, or sound object with the corresponding identifier will be placed when the electronic book is displayed (Spec. 5, bottom).
2. The reference History is an interesting document in HTML (Hyper-text Markup Language) code with the standard tags surrounding different sections of the text.
3. The reference Style is the standard for HTML style sheets. (Style, 1). In section 1.1 there is an example of four ways of linking the style sheet to the body document, including linking to the sheet using a document identifier "text/css." (Style 6, bottom).

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86

(Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

“In reviewing the [E]xaminer’s decision on appeal, the Board must necessarily weigh all of the evidence and argument.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Representative claim 1 recites a method to retrieve data from information structures. The single step is to generate a template with a certain data structure. Limitations thereafter specify the nature of the data in the information structure and the template.

Our guiding court states: “As the PTO notes, ‘the Supreme Court has recognized only two instances in which such a method may qualify as a section 101 process: when the process ‘either [1] was tied to a particular apparatus’ or [2] operated to change materials to a “different state or thing.”’ *In re Comiskey*, 499 F.3d 1365, 1377 (Fed. Cir. 2007) (citing PTO Supp. Br. 4 (quoting *Parker v. Flook*, 437 U.S. 584, 588 n.9)).

A claim for computer instructions embodied in a signal only is not considered by this office to be statutory under 35 U.S.C. 101.² This policy

² See, e.g., *In re Nuijten*, 500 F.3d 1346, 1359 (Fed. Cir. 2007). *Ex Parte Hartmann*, No. 2006-1607, 2006 WL 2700810, at 4 (B.P.A.I. 2006) (non-precedential). ‘Signals’ are not statutory subject matter.

has been confirmed by the Court of Appeals for the Federal Circuit in *In re Nuijten*. “A transitory, propagating signal like Nuijten’s is not a ‘process, machine, manufacture, or composition of matter.’ Those four categories define the explicit scope and reach of subject matter patentable under 35 U.S.C. § 101; thus, such a signal cannot be patentable subject matter.” *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007).

However, our reviewing court has held that nonfunctional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). Cf. *In re Gulack*, 703 F.2d 138 1, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

Laws of nature, physical phenomena, and abstract ideas are excluded from patent protection. *Diamond v. Diehr*, 450 U.S. 175, 185 (1981).

The test for statutory subject matter is whether the claimed subject matter is directed to a “practical application,” i.e., whether it is applied to produce “a useful, concrete and tangible result.” See *State St. Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998).

When “non functional descriptive material” is recorded or stored in a memory or other medium (i.e., substrate) it is treated as analogous to printed matter cases where what is printed on a substrate bears no functional relationship to the substrate and is given no patentable weight. See *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (“Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability.

Although the printed matter must be considered, in that situation it may not be entitled to patentable weight.”). *See also Ex parte Curry*, 84 USPQ2d 1272 (BPAI 2005) (nonprecedential) (Federal Circuit Appeal No. 2006-1003, *aff’d* Rule 36 Jun. 12, 2006). The Examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). *See also Ex parte Nehls*, <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071823.pdf> (BPAI Jan. 28, 2008); *Ex parte Mathias*, 84 USPQ2d 1276 (BPAI 2005) (nonprecedential) (191 Fed.Appx. 959 (Fed. Cir. 2006)).

ANALYSIS

From our review of the administrative record, we find that the Examiner has presented a *prima facie* case for the rejections of Appellant’s claims under 35 U.S.C. § 103(a) on pages 3 to 12 of the Examiner’s Answer. In opposition, Appellant presents a number of arguments.

*Arguments with respect to the rejection
of claims 8, 9, 13, 15, and 17
under 35 U.S.C. § 103 [R1, R5]*

Appellant has chosen to argue the independent claims together, applying the same arguments to both rejections (App. Br. 8-10).

Appellant first argues that “[t]here is simply no teaching or suggestion of a ‘body data unit’ and a ‘part data unit’ in the History document.” (App. Br. 8, middle). We agree with the Examiner that this observation is accurate. However, the rejections [R1] and [R5] were founded on a combination of

History and Style, not on a single reference, and thus the argument is not dispositive.

Appellant next considers the Style reference, and argues that the <P STYLE= "color: green"> reference is within the <BODY> tags, and therefore does not comply with the limitation "includes no data to be actually displayed on the display screen." (App. Br. 9, middle). We have reviewed Appellant's argument and Examiner's response (Ans. 12, 13). We agree with the Examiner in that the Style sheet is not displayed on the display screen but rather specifies how the substantive document (e.g. History) will be displayed, corresponding to the part data.

We thus do not find error in the Examiner's rejection of these claims.

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 8, 9, 13, 15 or 17 under [R1] or [R5]. The claims dependent thereon are also therefore rejected without error.

OTHER ISSUES

REJECTION OF CLAIMS 1, 2, 3 TO 7 AND 18 TO 20 UNDER 37 C.F.R. § 41.50(B)

We make the following two new grounds of rejection using our authority under 37 C.F.R. § 41.50(b).

Rejections:

R6: Claims 1, 2, 3-7, 19 and 20 are rejected under 35 U.S.C. § 101 for being non-statutory, addressed only to electronic data with no computer readable medium or structure.

R7: Claim 18 is rejected under 35 U.S.C. § 101 for being non-statutory, being addressed to a transmitted data signal.

“It is well established that ‘[t]he first door which must be opened on the difficult path to patentability is § 101.’ *State St. Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1372 n. 2 (Fed.Cir.1998) (quoting *In re Bergy*, 596 F.2d 952, 960 (CCPA 1979)) (quoted in *In re Comiskey*, 499 F.3d 1365, 1371 (Fed. Cir. 2007). “Only if the requirements of § 101 are satisfied is the inventor ‘allowed to pass through to’ the other requirements for patentability.” (*Id.*). Thus, previous to considering the Examiner’s rejections of these claims in rejections [R1] to [R5], the question of their being suitable statutory subject matter for a U.S. patent must be considered.

ANALYSIS

*Arguments with respect to the rejection
of claims 1, 2, 3 to 7, 19 and 20
under 35 U.S.C. § 101 [R6]*

The claims recited in rejection [R6] are all addressed to a data model expressed in electronic code. The claims recite no memory device or

substrate and no computer readable medium on or into which the data structure is recorded. As such these claims are clearly distinguished from the claims in *In re Lowry*, 32 F.3d at 1581, which read: “1. A memory for storing data for access by an application program”

Comparing the facts before us to the fact situation in *Lowry*, we find there is no functional relationship in the instant case between the data objects and the substrate, as there is no substrate whatsoever recited in the claims. The elements mentioned in the claims, e.g. body data units, identifiers, and other such structures, are disclosed to be only coded information and data of a certain utility, meaning, or format (Spec. 12, top). The data structure is expressed as electronic book contents of a certain form, as an abstract intangible construct, or idea and not as an element in a statutory machine, process or manufacture. “In that context, the Supreme Court has held that a claim reciting an algorithm or abstract idea can state statutory subject matter only if, as employed in the process, it is embodied in, operates on, transforms or otherwise involves another class of statutory subject matter....” *In re Comiskey*, 499 F.3d at 1376. We find in the recited claims no transformation of another class of statutory subject matter, as there is no process recited in the claims.

We are left with only an abstract organization of data in the claims of [R6], and we conclude this does not satisfy the requirement of 35 U.S.C. § 101 for statutory subject matter.

*Arguments with respect to the rejection
of claim 18
under 35 U.S.C. § 101 [R7]*

Claim 18 is drawn to “[a] computer data signal generated by encoding electronic book contents processed by a computer... said data signal being a carrier transmitted via a network.”

Such a claim for computer instructions embodied in a signal only is not considered by this office to be statutory under 35 U.S.C. 101.³ This policy has been confirmed by the Court of Appeals for the Federal Circuit in *In re Nuijten*. “A transitory, propagating signal like Nuijten's is not a ‘process, machine, manufacture, or composition of matter.’ Those four categories define the explicit scope and reach of subject matter patentable under 35 U.S.C. § 101; thus, such a signal cannot be patentable subject matter.” *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007).

DECISION

We have sustained the Examiner's prior art rejections [R1] to [R5] under 35 U.S.C. § 103(a) with respect to claims 1-20, all the claims on appeal. Moreover, we have entered two new grounds of rejection [R6] and [R7] under 37 C.F.R. § 41.50(b) for claims 1-7, 18, 19 and 20 as failing to recite statutory subject matter under 35 U.S.C. § 101.

With respect to the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides that “Appellant may file a single request for rehearing within two months from the date of the original decision of the Board.”

³ See, e.g., *In re Nuijten*, 500 F.3d 1346, 1359 (Fed. Cir. 2007). *Ex Parte Hartmann*, No. 2006-1607, 2006 WL 2700810, at 4 (B.P.A.I. 2006) (non-precedential). ‘Signals’ are not statutory subject matter.

In addition to affirming the Examiner's rejections of the claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment, or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for

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Application 10/049,315

final action on the affirmed rejection, including any timely request for rehearing thereof.

AFFIRMED

37 C.F.R. § 41.50(b)

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EDWARDS ANGELL PALMER & DODGE LLP
P.O. BOX 55874
BOSTON, MA 02205